

Docket No.: 103864.134-US1
Serial No. 10/634,990

PATENT

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REMARKS

In the Office Action, the Examiner noted that Claims 34-41 and 43-58 are allowed over the prior art of record, and that claims 72-74 would be allowable if rewritten in independent form. Claims 59-61, 68, 70 and 71 are the only claims that stand currently rejected.

Applicant graciously acknowledges the Examiner's indication of allowable subject matter.

By this Amendment, Claims 59, 68 and 70 have been amended and Claim 71 has been cancelled. Thus, Claims 34-41, 43-61, 70 and 72-74 are presented for examination. Applicant respectfully submits that no new matter has been introduced into the present application, and that the amendments to the claims are supported by the originally filed specification and drawings.

The Examiner's rejections are traversed below.

Rejections Under 35 USC Sections 102 and 103

Claims 38-40, 42-46, 48, 53-61 and 68 stand rejected based on the following prior art references: Fattal et al. U.S. Patent 4,927,486; combined with Vijuk U.S. Patent 6,273,411 under 35 USC Section 102 and 103.

Applicant respectfully traverses this rejection.

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U.S. Patent 6,273,411 entitled "Booklet forming method and apparatus" relates to a method of forming a booklet from a single sheet of paper by depositing an adhesive along a linear path on a single sheet of paper and folding the sheet by making folds parallel to first direction, to form interconnected panels. Accordingly, this prior art reference does not at all discuss or relate to customer specific labels. In addition, there is no motivation or suggestion to utilize this prior art references for the labeling of patient specific pharmaceutical and/or prescription orders.

U.S. Patent 4,927,486, entitled "System for applying labels to pallets movable along a conveyor line," incorporates a sensor that senses the presence of a pallet at a label applying station on the conveyor line and a label printer/dispenser produces labels for applying to the pallet. A robot arm moves a label receiver/applier between a first position, adjacent the label printer/dispenser for receiving a label, a second position adjacent the label applying station for applying a label to the pallet, and a third position whereat a label reader, also mounted on the robot arm, reads the label. A processor controls the robot arm, the label reader and the label printer and dispenser and compares the text of the read label to determine if it is correct, and it also determines whether the label is correctly positioned. Similarly, there is no motivation or suggestion to utilize this prior art reference for the labeling of patient specific pharmaceutical and/or prescription orders in combination with a reduced label.

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The currently amended claims have been amended in accordance with the Examiner's indication of allowable subject matter, in its entirety or in part. Accordingly, these claims recite subject matter that is not considered to be a narrowing description, but rather recite subject matter that Applicant considers to be commensurate with the scope of protection of the present invention, as well as any equivalents that are substantially similar to the presently claimed invention.

In addition, Applicant respectfully submits that the combination of features in the rejected claims is patentably distinguishable over the prior art, when each claim is considered a whole, for each independent combination recited therein.

In addition, the remaining dependent and independent claims are also asserted to be patentable over the prior art, for each of the independent combination of limitations recited therein.

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CONCLUSION

Applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, Applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant is providing examples of why the claims described above are distinguishable over the cited prior art.

Applicant wishes to clarify for the record, if necessary, that the claims have been amended to expedite prosecution and/or explicitly recite that which is already present within the claims. Moreover, Applicant reserves the right to pursue the original and/or complimentary subject matter recited in the present claims in a continuation application.

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Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicant's best attempt at providing one or more definitions of what the Applicant believes to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicant is seeking for this application. Therefore, no estoppel should be presumed, and Applicant's claims are intended to include a scope of protection under the Doctrine of Equivalents and/or statutory equivalents, i.e., all equivalents that are substantially the same as the presently claimed invention.

Further, Applicant hereby retracts any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicant specifically retracts statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicant respectfully submits that the rejections have been overcome and should be withdrawn.

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For all the reasons advanced above, Applicant respectfully submits that the Application is in condition for allowance, and that such action is earnestly solicited.

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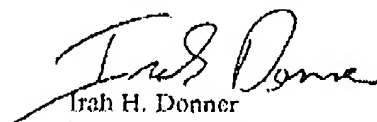
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The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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